

REMARKS

Status of the Application

Claims 1-37 are pending and remain rejected following the issuance of the *Advisory Action* in this matter. Applicants, through this submission, hereby amend claims 1, 9, 16 and 25.

Motivation to Combine

The Applicants, in the amendment dated September 16, argued that U.S. patent number 6,715,007 to Williams should not be combined with U.S. patent number 6,715,007 to Merchant or U.S. patent number 6,038,216 to Packer. See *September 16 Amendment*, 9. Specifically, the Applicants contended that "there is no suggestion in the prior to combine the references." *Id.* The Applicants then noted that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." *Id.* (emphasis added) (quoting *Ex parte Skinner*, 2 USPQ2d 1788) (BOPAI 1986). The Examiner's recognition of *the problem*—"effectively and efficiently routing and processing of information in [a] packet switching network"—is not the same as identifying the *motivation to combine references* in the art *to achieve a purported solution*. *Final Office Action*, 7.

The Examiner's reliance on abstract objectives, rather than concrete suggestions of how the teachings may be combined to solve specific problems does not constitute the requisite *prima facie* case of obviousness. As such, while the Applicants recognize that "[t]he test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art," the Applicants contend the Examiner has yet to identify that required suggestion. *Advisory Action*, 2 (citing *In re*

McLaughlin, 170 USPQ 209 (CCPA 1971)). As such, the Applicants continue to contend the Examiner has yet to establish a *prima facie* case of obviousness.

Failure to Teach All Claimed Limitations

The Examiner contends that "the rejection of the claims 1-33, 35-37" as "cited and applied in the last office actions" is "maintained in this office action." *Advisory Action*, 3. Applicants respectfully traverse in that the references of record fail to teach each and every limitation of the presently claimed invention.

For example, claim 1 as amended recites:

A method of regulating an average rate of transmission on a computer network employing TCP, comprising:

determining an amount of available space in a receive buffer at a receiver;

reading data from the receive buffer such that the amount of available space in the receive buffer is maintained at a regulated value; and

regulating a rate at which data is delivered to the receive buffer based on a priority of the data, such that the priority of the data results in an absolute transfer rate of the data, wherein the priority of the data is a function of the identity the receiver.

The Applicants contend the references of record fail to disclose, at the least, regulating a rate at which data is delivered to a receive buffer based on (1) a priority of the data; (2) at an absolute transfer rate of the data; and (3) the priority of the data being a function of identity of the receiver.

The Examiner contends that U.S. patent number 5,933,413 to Merchant et al. discloses "a priority control selectively allocat[ing] host computer resources based on network transmission and network reception by the network interface, and based on available space in the receive buffer, available data in the transmit buffer." *Advisory Action*, 2 (referencing Merchant at col. 2, l. 25 et seq. and col. 5, line 27 et seq.).

The Applicants submit that the teachings of Merchant, either alone or in combination with any other references, fail to teach the limitations of claim 1 in that Merchant “prioritizes *the host computer resources* for either storing the first data bytes into the memory buffer or removing the second data bytes from the memory buffer.” Col. 2, l. 42-45 (emphasis added). In doing so, Merchant “ensures that overflow of the buffer for received data and underflow of transmit data is minimized.” Col. 2, l. 47-49. Merchant emphasizes the need to control buffer under/overflow at the host computer. Claim 1 of the present application, however, “regulat[es] a *rate at which data is delivered* to the receive buffer based on a priority of the data” (emphasis added). That is, claim 1 concerns “regulating an average rate of transmission” as is recited in the preamble of the claim and *not* necessarily the storage/removal rate of data as is described in Merchant. See Col. 2, l. 37-42.

The Applicants note that “a claim preamble has the import that the claim as a whole suggests for it.” *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995). “If the claim preamble, when read in the context of the entire claim, recites limitations of the claim . . . then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999). The Applicants respectfully suggest the Examiner fails to appreciate the import of the preamble with regard to claim 1’s governance of regulating transmission whereas Merchant concerns buffer resource management. As such, the Applicant respectfully suggests the Examiner’s reliance on Merchant—either alone or in combination with any other reference—fails to disclose the limitations of claim 1 and, therefore, the rejection is overcome.

Further, Merchant fails to disclose an absolute transfer rate of the data as is recited in, for example, claim 1. The Examiner suggests that Merchant discloses this limitation in the reference to column 10, line 39 et seq. See *Advisory Action*, 3. This reference to Merchant, however, concerns priority with regard to removal and storage of data in the buffer. Again, Merchant is focused on buffer management and not regulation of transmission rate. As such, the Applicant again contends the Examiner’s

reliance on Merchant, either alone or in combination with any of the other references of record, as the basis for the present rejection to be in error and, therefore, the rejection to have been overcome.

Finally, the Applicant contends Merchant fails to disclose the priority of the data being a function of identity of the receiver. For example, the present application describes different priorities being assigned to data transfers as a function of the identity of the receiver. See *Specification*, p. 10, l. 19-20. The Applicants' review of the Merchant reference finds no such teaching. Such a teaching is similarly lacking in the other references of record. As such, the Applicants contend the references of record fail to teach each and every limitation of, for example, claim 1 and the Examiner's rejection is overcome.

The Applicants note that similar rejections are present in the other independent claims and are allowable for at least the same reasons. The Applicants also note that the dependent claims, representing further limitations of the allowable base claims, should further be allowable as a matter of law. See 35 U.S.C. § 112, ¶ 4.

CONCLUSION

Applicants believe the Examiner's 35 U.S.C. § 103 rejections have been overcome in their entirety in that the cited references – either individually or in combination – fail to teach each and every limitation of the claims as amended. The Applicants further believe the Examiner's proposed combinations to lack a motivation to combine thus representing an absence of a *prima facie* case of obviousness. Allowance of the application is therefore requested. If the Examiner has any questions concerning the present application, the Examiner is invited to contact the Applicants' undersigned representative.

Respectfully submitted,
Fouad A. Tobagi et al.

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By: Kenneth M. Kaslow
Kenneth M. Kaslow, Reg. No. 32,246
Carr & Ferrell LLP
2200 Geng Road
Palo Alto, CA 94303
T : 650.812.3400
F : 650.812.3444